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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,573	02/12/2001	William R. Bandy	1689.0070001	1620
26111	7590	05/25/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PYZOCHA, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,573

Applicant(s)

BANDY ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 and 31-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 13-18 and 31-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 13-18, and 31-41 are pending.
2. The amendment of 04/20/2004 has been received and considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 37-38 and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Wu et al (U.S. 6,748,533).

As per claim 37, Wu et al discloses a marking representing a data set and a second marking representing another data set with a relationship between the two data sets (see column 12 lines 58-67).

As per claim 38, Wu et al discloses an invisible marking (see column 13 lines 1-4).

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As per claim 40, Wu et al discloses the relationship defined by encryption (see column 12 line 65 through column 13 line 1).

As per claim 41, Wu et al discloses the use of a framing image (see column 12 lines 50-53).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-17 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith et al (U.S. 6,069,955) and further in view of Kuhns et al (U.S. 3,691,350).

As per claims 13 and 31, Coppersmith et al discloses reading and converting the data sets (see column 3 lines 53-59).

Coppersmith et al fails to disclose comparing the data sets.

However, Kuhns et al teaches comparing two read data sets (see abstract).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Kuhns et al's method of comparing data to compare Coppersmith et al's two data sets.

Motivation to do so would have been to determine the presence of counterfeited material (see Kuhns et al Abstract).

As per claims 14 and 32, the modified Coppersmith et al and Kuhns et al system discloses the data sets being numeric sequences (see Coppersmith column 3 lines 31-35 where the labels being read are these serial numbers).

As per claims 15 and 33, the modified Coppersmith et al and Kuhns et al system discloses the use of an encryption algorithm (see Coppersmith column 3 lines 41-43).

As per claims 16 and 34, the modified Coppersmith et al and Kuhns et al system discloses the use of a bar code (see Coppersmith column 4 lines 47-49).

As per claims 17 and 35, the modified Coppersmith et al and Kuhns et al system discloses one of the patterns being invisible (see Coppersmith column 3 lines 47-48).

7. Claims 18 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Coppersmith et al and Kuhns et al system as applied to claims 13 and 31 above, and further in view of Liang (U.S. 5,867,586).

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The modified Coppersmith et al and Kuhns et al system fails to disclose the use of the infra-red light spectrum.

However, Liang discusses discloses the use of the infra-red light spectrum (see column 2 lines 58-61).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the infra-red light spectrum of Liang with the modified Coppersmith et al and Kuhns et al system.

Motivation to do so would have been a method to apply invisible markings to an article (see column 2 lines 58-61).

8. Claims 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al as applied to claim 37 above, and further in view of Liang.

Wu et al fails to disclose the use of the infra-red light spectrum.

However, Liang discusses discloses the use of the infra-red light spectrum (see column 2 lines 58-61).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the infra-red light spectrum of Liang with the system of Coppersmith.

Motivation to do so would have been a method to apply invisible markings to an article (see column 2 lines 58-61).

Response to Arguments

9. Applicant's arguments filed 04/20/2005 have been fully considered but they are not persuasive.

10. Applicant's arguments with regard to claims 13-17 and 31-35 are moot in view of new grounds of rejections.

11. Regarding Applicant's argument that Wu fails to disclose "a randomly-generated marking," the invisible watermark in column 13 lines 1-4 is the randomly generated marking.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shah et al (US 5778066) teaches comparing two marks to determine the authenticity of an article and Moore (US 5592561) teaches and anti-counterfeiting system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER